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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/254,005	03/01/1999	TAKAFUMI ATARASHI	Q53451	6345

7590 04/23/2004  
SUGHRUE MION ZINN MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE NW  
WASHINGTON, DC 20037

EXAMINER
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KRUER, KEVIN R

ART UNIT	PAPER NUMBER
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1773

DATE MAILED: 04/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/254,005

Applicant(s)

ATARASHI ET AL.

Examiner

Kevin R Kruer

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--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED March 19, 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 19 March 2004. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☒ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: see attached.

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: 11 and 13.

Claim(s) objected to: \_\_\_\_\_.

Claim(s) rejected: 1, 3, 5-10 and 12.

Claim(s) withdrawn from consideration: \_\_\_\_\_.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

***Advisory Action***

The after-final amendment filed March 19, 2004 has been fully considered. The proposed amendments will not be entered because they present new claims without canceling a corresponding number of finally rejected claims. Furthermore, the proposed amendments will not be entered because they raise new issues that would require further search and consideration. Specifically, the limitations of new claims 14 and 15 have not been previously considered. The proposed amendment also does not place the application in better condition for appeal by materially reducing or simplifying the issues on appeal.

Applicant argues that the proposed amendments to claim 12 overcome the outstanding 35 U.S.C.112, first paragraph rejection. However, the proposed amendments have not been entered for the reasons specified above. Therefore, Applicant's arguments with regards to claim 12 are moot.

With regard tot the rejection of claims 1, 3, 5, 7, 9, and 10 under 35 U.S.C. 103(a) as being unpatentable over Beane, Applicant argues that Beane does not teach a consolidated material of coated powders in the form of a molded, three-dimensional article. Specifically, Beane teaches (FIG 11 and 12) particles (either coated or not coated) co-deposited on an article by means of electrolytic plating. Applicant argues such a teaching does not read on the claimed consolidated material of coated particles. The examiner respectfully disagrees. Beane teaches that the particles are sintered, after which the resulting coating exhibits intrinsic properties (col 10, lines 45+). Thus, the examiner takes the position that the particles are "consolidated." Furthermore, a

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particle is inherently three-dimensional. Thus, a coating comprising said particles is inherently "three-dimensional." The examiner concedes that the coating of Beane is not molded or subjected to heat treatment under pressure. However, the courts have held that the method of making a product does not patentably distinguish a claimed product from a product taught in the prior art unless it can be shown that the method of making the product inherently results in a materially different product. In the present application, there is no showing that "molding" or heat pressing will inherently result in product that is materially different than the product taught in Beane.

Applicant argues that newly proposed claim 14 distinguishes the claimed invention from the product taught in Beane. Applicant's arguments are moot since claim 14 has not been entered.

With respect to claim 10, Applicant argues that the examiner has not indicated an embodiment in Beane that would be within the claimed capacitor comprising a base particle having plural coating films thereon, including a dielectric material layer and a conductor layer. The examiner respectfully disagrees. Beane teaches a particle that can be coated with multiple coatings, wherein each coating may be either metallic or non-metallic (see the discussion of Beane in the Office Action mailed 4/9/2003).

Applicant argues that the material disclosed in Beane comprises only two layers and is considered to have a small charge storing capacity even if a metal and nonmetal are used. On the other hand, the charge storing capacity becomes larger with an increase in the number of alternate superpositions of a metal layer and a dielectric layer. In response to applicant's argument that the references fail to show certain

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features of applicant's invention, it is noted that the features upon which applicant relies (i.e., large numbers of alternate superpositions of metal layers and dielectric layers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

With regard to the rejection of claims 1, 3, 6-8 and 10 under 35 U.S.C. 103(a) as being unpatentable over Paszkiet, Applicant argues that the resulting structure is different from that achieved by the present invention where the particles are disposed in close contact with each other by eliminating spacing there between. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., lack of voids between the particles) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant further argues that Paszkiet does not read on the claimed molded, three-dimensional article that has been subjected to heat treatment under pressure to consolidate the particles. The examiner respectfully disagrees. Particles are inherently three-dimensional. Thus, a coating comprising said particles is also inherently three-dimensional. The particles are consolidated together (col 3, line 66), as shown in Fig 4. The coating of Paszkiet is not molded or subjected to heat treatment under pressure. However, the courts have held that the method of making a product does not patentably distinguish a claimed product from a product taught in the prior art unless it can be

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shown that the method of making the product inherently results in a materially different product. In the present application, there is no showing that "molding" or heat pressing will inherently result in product that is materially different than the product taught in Paszkiet.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin R Kruer whose telephone number is 571-272-1510. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on 571-272-1516. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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